

REMARKS

Claims 1-9, 11-12, 14-17, and 19-23 were pending at the time the Office Action was issued, with claims 10, 13, and 18 having been previously canceled.

Claims 1, 5, 11, 16, 22, and 23, of which claims 1, 11, 16, and 23 are independent claims, are currently amended. Claims 5 and 22 are amended to resolve a potential antecedent basis problem; applicants apologize for not previously addressing these points.

No claims are presently canceled.

Thus, claims 1-9, 11-12, 14-17, and 19-23 remain pending.

Summary of Interview

Applicants and their undersigned representative thank the Examiner for agreeing to a telephonic interview to discuss the claims and the cited references. The Examiner was kind enough to review a proposed amendment and response prior to the telephonic interview. Applicant's representative is grateful to the Examiner for her time and her candor.

The Examiner and applicant's representative discussed the foregoing amendments to independent claims 1, 11, 16, and 23. The Examiner agreed that the amendments presented would further the prosecution of the case and, at least would necessitate reconsideration of the grounds for rejection.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-9, 11-12, 14-15, and 23 were rejected under 35 U.S.C. § 103(a). Specifically, claims 1-9, 11-12, 14-15, and 23 were rejected as being unpatentable over Case Western Reserve

University (CWRU), "Introduction to HTML" (hereinafter "CWRU"), in view of Ayers, "AbiWord's Potential" (hereinafter "Ayers"); in view of Rohr, "RE: Styles Again" (hereinafter "Rohr"); and U.S. Patent No. 6,538,673 B1 to Maslov (hereinafter "Maslov"). Claims 16-17 and 19-22 were rejected as being unpatentable over CWRU in view of Ayers, Rohr, Maslov, and Lemay, "Teach Yourself Web Publishing with HTML in 14 Days, Professional Reference Edition" (hereinafter "Lemay"). Applicants respectfully traverse the rejections. Independent claims 1, 11, 16, and 23 are currently amended to clarify the distinctions between the claims and the cited references.

Claim 1 is patentable over the cited references for at least three reasons. Claim 1 as amended is reproduced below for the convenience of the Examiner:

1. (Currently Amended) A method for representing list information in a markup language document, comprising:
internally representing an application document in an application, wherein the internal representation is in a non-markup language format that is native to the application and the internal representation comprises unique properties for describing lists of data within the document, wherein the unique properties are defined by the application;
determining one or more unique properties corresponding to a list that relates to at least one section of the application document;
mapping the determined properties of the list into at least one of a markup language element, an attribute, and/or a value; and
storing the mapped properties of the list in the markup language document, wherein the markup language document is manipulable on a system including one of a server and another system to substantially reproduce the list without using the application that generated the markup language document.

First, with all respect, the Rohr fails to overcome the shortcomings of CWRU and the other references in failing to teach or suggest an "internal representation . . . that is native to the application" where "the internal representation comprises unique properties for describing lists of data within the document, wherein the unique properties are defined by the application" as

recited by claim 1. In fact, Ayers and Rohr teach away from what claim 1 recites. The Office Action quotes Ayers for the proposition that “*An *.abi file is written in XML and thus is also in ASCII format; the files can be read by any text editor.*” (Office Action, Numbered Section 5, Middle Paragraph on Page 4, quoting Ayers Page 2, Fourth Paragraph; emphasis added). If the file format of Ayers can be read by any text editor, surely, this is not a native file format that “comprises unique properties for describing lists of data within the document, wherein the unique properties are defined by the application” as recited by claim 1. In fact, all of the references cited teach both using an XML file format using standardized properties that are *not* specific to the application. In other words, by teaching the use of standardized XML properties to generate the document, the references teach the opposite of what claim 1 recites. Thus, the rejection of claim 1 under 35 U.S.C. § 103(a) must be withdrawn against claim 1.

Second, respectfully, the Office Action cannot rely on the cited references for teaching “mapping the determined properties of the list into at least one of a markup language element, an attribute, and/or a value” because such a reading ignores limitations expressly recited in the claim. The Manual of Patent Examining Procedure is clear that “All words in a claim must be considered in judging the patentability of that claim against the prior art.” (MPEP § 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). The Office Action relies on CWRU as teaching “at least one section of the document are mapped to a markup language and inherently stored,” but this assertion both relies on a loose paraphrasing of claim 1 and ignores that claim expressly recites the use of different formats.

In teaching XML, the references fail to separately recite (1) an “internal representation” that is “native to the application and the internal representation comprises unique properties for

describing lists of data within the document, wherein the unique properties are defined by the application” and (2) “mapping the determined properties of the list into at least one of a markup language element” and “storing the mapped properties of the list in the markup language document.” The references only teach storing documents in a markup language document. Thus, the references fail to teach both an internal representation *and* a markup language document. Moreover, because the references teach storing in a markup language document, the references would not teach mapping the determined properties of the list into at least one of a markup language and storing the mapped properties in a markup language document. Applicants submit that none of the other references, such as Rohr and Ayers that also contemplate storing data solely in a markup language format, fail to overcome the shortcomings of CWRU. Respectfully, the references only teach or suggest the limitations of claim 1 if one ignores the express wording of claim 1. Thus, the rejection should be withdrawn against claim 1.

Third, to clarify the distinctions between claim 1 and the cited references, applicants have amended claim 1 to recite that “the internal representation is in a non-markup language format that is native to the application.” The cited references teach using a native XML format. Thus, because the references fail to teach a native non-markup language format, the references fail to teach the limitations of claim 1, and the rejection under 35 U.S.C. § 103(a) must be withdrawn against claim 1.

Claim 11 also is patentable over the cited references for at least three reasons. Claim 11 as amended is reproduced below for the convenience of the Examiner:

11. (Currently Amended) A computer storage medium for representing list definitions and instances in a markup language document, comprising:

internally representing a word-processing document in a word-processing ~~an~~ application, wherein the internal representation is in a non-markup language format that is native to the application and the internal representation comprises unique properties for describing lists of data within the document, wherein the unique properties are defined by the application;

determining one or more unique properties relating to a list used within the word-processing document;

based at least in part on the determined properties, determining whether the list is a new list that follows a previously determined list;

including a list override with the determined properties when the list is a new list such that the instance of the list is separated from the instance of the previously determined list;

mapping the determined properties into at least one of a markup language element, an attribute, and/or a value; and

storing the mapped properties in the markup language document such that the list is substantially maintained when the markup language document is parsed by an application and the markup language document is manipulable on a system including one of a server and another system to substantially reproduce the list without using the application that generated the markup language document.

The Office Action collectively rejects claim 11 with claim 1. In the interest of brevity, applicants briefly summarize its remarks with regard to claim 1. First, none of the cited references teach or suggest an “internally representing a word-processing document in a word-processing application” where “the internal representation comprises unique properties for describing lists of data within the document, wherein the unique properties are defined by the application” as recited by claim 11. Because the references all deal with XML documents, the references teach *standardized* properties, rather than unique properties and, thus, the references only teach away from what claim 11 recites. Second, the Office Action ignores the expressed limitations of the claims in finding the cited references teach “mapping the determined properties of the list into at least one of a markup language element, an attribute, and/or a value.” Again, if an internal XML representation is used, there would be no mapping to a markup language element, thus, the references fail to teach this limitation. Third, as amended, claim 11 recites that

“the internal representation is in a non-markup language format that is native to the application.”

None of the references discloses a native, non-markup language format. The cited references fail to teach or suggest at least these three limitations and, thus, the rejection under 35 U.S.C. § 103(a) must be withdrawn against claim 11.

Claim 23 also is patentable over the cited references for at least three reasons. Claim 23 as amended is reproduced below for the convenience of the Examiner:

23. (Currently Amended) A method for representing list information in a markup language document, comprising:
inputting an application document that has been generated by an application that uses a non-markup language file format that is specific to the application, wherein the file format comprises unique properties of lists, wherein the unique properties are defined by the application;
determining one or more unique properties corresponding to a list that relates to at least one section of the application document;
mapping the properties of the list into at least one of a markup language element, an attribute, and/or a value; and
storing the properties of the mapped list properties in the markup language document whereby applications different from the application can understand the mapped list properties stored in the markup language document manipulable on a system including one of a server and another system to substantially reproduce the list without using the application that generated the markup language document.

The Office Action collectively rejects claim 23 along with claims 1 and 11. In the interest of brevity, applicants briefly summarize its previous remarks. First, none of the references teaches or suggests an application “wherein the file format comprises unique properties of lists, wherein the unique properties are defined by the application.” By contrast, references all deal with XML documents using standardized properties, thus teaching away from what claim 23 recites. Second, the Office Action ignores the expressed limitation of claim 23 of “mapping the determined properties of the list into at least one of a markup language element, an attribute, and/or a value” and storing the properties in a markup language document. In using

XML application formats as taught by the references, the references would neither use a separate markup language document nor map properties to markup language elements as recited in claim 23. Thus, the references fail to teach this limitation. Third, as amended, claim 23 recites that “the internal representation is in a non-markup language format that is native to the application.” None of the references discloses a native, non-markup language format. The cited references fail to teach or suggest the limitations of claim 23 for at least these three reasons. The rejection under 35 U.S.C. § 103(a) must be withdrawn against claim 23.

Claim 16, although rejected under 35 U.S.C. § 103(a) over a different combination of references, also is patentable over the cited references for at least the same three reasons. Claim 16 as amended is reproduced below for the convenience of the Examiner:

16. (Currently Amended) A computer system for representing list definitions and instances in a markup language document, comprising:
an application that is configured to:
internally represent an application document in an application in a non-markup language format that is native to the application and comprising unique properties for describing lists of data within the document, wherein the unique properties are defined by the application;
determine one or more unique properties relating to a list included in at least one section of the application document;
map the determined properties into at least one of a markup language element, an attribute, and/or a value; and
store the mapped properties in the markup language document, wherein the markup language document is manipulable on a system including one of a server and another system to substantially reproduce the list without using the application that generated the markup language document; and
a validation engine configured to validate the stored markup language document.

Because the Office Action rejects claim 16 over many of the same assertions with which the Office Action rejected claims 1, 11, and 23, in the interest of brevity, applicants briefly summarize its previous remarks. First, none of the references teaches or suggests an application

configured to “internally represent an application document in a format “native to the application and comprising unique properties for describing lists of data within the document, wherein the unique properties are defined by the application” as recited by claim 16. Because the references all deal with XML documents, the references teach *standardized* properties, rather than unique properties and, thus, the references only teach away from what claim 11 recites. Second, the Office Action ignores the expressed limitations of the claims that recite the format native to the application, the markup language document, and that the system is configured to map the determined properties of the list into at least one of a markup language element, an attribute, and/or a value.” Again, if an internal XML representation is used as taught by the references, there would be no mapping to a markup language element let alone the use of a markup language document as separate recited in claim 16. Thus, the references fail to teach these limitations. Third, as amended, claim 11 recites that “the internal representation is in a non-markup language format that is native to the application.” None of the references discloses a native, non-markup language format. The cited references fail to teach or suggest at least these three limitations and, thus, the rejection under 35 U.S.C. § 103(a) must be withdrawn against claim 16.

Claims 2-9, 12, 14-15, 17, and 20-22 depend from and apply additional limitations to the respective claims from which each depends. Accordingly, claims 2-9, 12, 14-15, 17, and 20-22 are patentable for at least the same reasons for which the respective independent claims are patentable. In the interest of reducing the number of issues for the Examiner to consider in this response, the foregoing discussion focuses on independent claims 1, 11, 16, and 23. The patentability of each remaining dependent claim is not separately addressed in detail. However, applicants’ decision not to discuss the differences between the cited art and each dependent claim

should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. As noted, a specific traverse of the rejection of each dependent claim is not required, because dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

CONCLUSION

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicants at the telephone number provided below.

Respectfully submitted,

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